

PATENT
Attorney Docket No. 403696

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SAITO et al.

Application No. 10/577,876

Art Unit: Unassigned

Examiner: Unassigned

Filed: April 28, 2006

For: METHOD FOR GLOSSING SOLID
SURFACE AND FILM-FORMING
COATING

**PETITION UNDER 37 CFR § 1.47 FOR EXAMINATION WITHOUT COMPLETION
OF DECLARATION BY AN INVENTOR WHO REFUSES TO SIGN**

Commissioner for Patents
Washington, D.C. 20231

11/09/2006 LLANDGRA 00000011 121216 10577876
04 FC:1463 Dear Sir:
200.00 DA

The Assignees of the referenced patent application, Nicca Chemical Co., Ltd., and Honda Motor Co., Ltd., through their attorney, petition, pursuant to 37 CFR § 1.47(a), for completion of the filing of the referenced patent application and the commencement of examination, although the third named inventor refuses to sign the Declaration.

The referenced patent application is the United States national phase application of Patent Cooperation Treaty Application No. JP2004/015529, which was filed on October 20, 2004 (“the PCT application”). The PCT application is based upon, and claims priority from, Japanese Patent Application No. 2003-381233, which was filed on November 11, 2003 (“the Japanese application”). The patent application names four inventors, namely, Toru Saito, Hirofumi Tochikawa, Masahiro Makino, and Hideaki Tojo.

All of the named inventors except for the third named inventor, Masahiro Makino, have signed an English language Declaration and Power of Attorney, as well as an English language Assignment assigning their interests in the patent application to the Assignees identified above. Copies of the Declaration and Power of Attorney and the Assignment are attached to a Declaration submitted with this Petition. The Assignment is being separately filed for recording by the Assignment Branch.

The third named inventor, Masahiro Makino, has refused to sign the Assignment and the Declaration for the referenced patent application. Mr. Makino is a former employee of Nicca Chemical and the invention was made in the course of his employment. In order to prepare the documents necessary for completion of the filing of the referenced U.S. Patent Application, contact was made with Mr. Makino, requesting his signature on the necessary documents.

The first contact with Mr. Makino was made by Naoki Ogura of the Intellectual Property Administration Section of Research and Development Division of Nicca Chemical, via e-mail, on May 16, 2006, requesting to make an appointment with Mr. Makino to obtain his signature on the necessary documents. Copies of that e-mail and its English translation are attached as Exhibit A. Mr. Ogura did not receive a reply to this e-mail until May 25, 2006.

A second contact was made with Mr. Makino by Mr. Ogura on May 25, 2006, via e-mail, including an attachment of the documents to be signed. Mr. Makino replied by e-mail on May 25, 2006, indicating his refusal to sign the documents. Copies of this e-mail exchange and its English translation are attached as Exhibit C.

The last known postal address for Mr. Makino is: Sun East B 203, 615, Aza Higashida, Nishiarai, Furukawa-shi, Miyagi 989-6133, Japan. The last known e-mail address of Mr. Makino is makino-ma@nifty.com.

In proof of the foregoing facts, attached is the Declaration from Mr. Naoki Ogura.

The petition fee of \$200.00 set forth in 37 CFR § 1.17(g) is attached.

Since all requirements for completion of the patent application pursuant to 37 CFR § 1.47(a) have been met by this factual showing, and since the three cooperating inventors have completed the necessary Declaration, Petitioners request that the patent application be deemed complete, that notice be given of that decision, and that the patent application be forwarded to the proper technology center for examination.

In re Appln. of SAITO et al.
Application No. 10/577,876

The petition fee set forth in 37 CFR 1.17(h) is attached.

Respectfully submitted,

Stephanie M. Lawley
Stephanie M. Lawley, Reg. No. 55,362
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, D.C. 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date: Nov. 6, 2006

PATENT
Attorney Docket No. 403696

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SAITO et al.

Application No. 10/577,876

Art Unit: Unassigned

Examiner: Unassigned

Filed: April 28, 2006

For: METHOD FOR GLOSSING SOLID
SURFACE AND FILM-FORMING
COATING

DECLARATION SUPPORTING THE PETITION UNDER 37 CFR §1.47

U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street Customer Window
Alexandria, VA 22314

Dear Sir:

I, Naoki Ogura, hereby declare the following:

1. I, Naoki Ogura, am a representative of the Intellectual Property Administration Section of the Research and Development Division of Nicca Chemical Co., Ltd. of Fukui City, Japan (Nicca Chemical).

2. An invention was jointly made by employees of Nicca Chemical and by an employee of Honda Motor Co., Ltd., of Tokyo, Japan (Honda Motor), for which Japanese Patent Application 2003-381233 was filed on November 11, 2003 (the Japanese application). The Japanese application named, as joint inventors, Toru Saito, Hirofumi Tochikawa, Masahiro Makino, and Hideaki Tojo, and was titled, translated into English, Method for Glossing Solid Surface and Film-Forming Coating Liquid. Nicca Chemical And Honda Motor are co-applicants of the Japanese patent application.

3. An international application based on and claiming priority to the Japanese application and which designated the United States and Canada was filed under the Patent Cooperation Treaty on October 20, 2004 as Application No. PCT/JP2004/015529 (the PCT application). The PCT application entered the national phase in the United States on April 28,

In re Appln. of SAITO et al.
Application No. 10/577,876

2006 and was accorded Application No. 10/577,876 ('876 application). This Declaration pertains to the '876 United States patent application.

4. Mr. Makino, the third named inventor, is a former employee of Nicca Chemical. The invention was made in the course of his employment.

5. In order to prepare the necessary documents for the filing of the Canadian and U.S. patent applications, I contacted Mr. Makino to request his signature on the necessary documents. A record of the negotiating process between Mr. Makino and me regarding the request for his signature is attached as Exhibit A. Because Mr. Makino's present address is unknown, I contacted Mr. Makino by e-mail on May 16, 2006 in order to arrange an appointment for a meeting with him to request his signature. Copies of this e-mail and its English translation are attached as Exhibit C. I did not receive a reply to this e-mail until May 25, 2006.

6. On May 25, 2006, I sent Mr. Makino another e-mail, requesting him to place his signature on the documents, and attaching to the e-mail the "English Patent Description," "Preliminary Amendment of Claim," "Declaration and Power of Attorney," and "Deed of Assignment" for the patent application in the United States, as well as the documents necessary for the application in Canada. My e-mail indicated that incentives for the assignment of inventions shall be provided in accordance with the terms and conditions stated in the "Control Procedures for Inventions and Ideas" and "Bylaws for Control of Inventions and Ideas" of Nicca Chemical. On May 25, 2006, I received an e-mail reply from Mr. Makino indicating that he refused to sign the necessary documents. Copies of this e-mail exchange, its English translation, the Declaration and Power of Attorney, and the Deed of Assignment, are attached as Exhibit B.

7. To the best of my knowledge and information, the last known address for Mr. Makino is: Sun East B 203, 615, Aza Higashida, Nishiarai, Furukawa-shi, Miyagi 989-6133, Japan. I communicated with him via e-mail at the following address: makino-ma@nifty.com.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further than these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of

In re Appln. of SAITO et al.
Application No. 10/577,876

the United States Code, and that such willful false statements may jeopardize the validity of
the application or any patent issued thereon.

June 27, 2006

Naoki Ogura

Naoki Ogura
Intellectual Property Administration
Section of the Research and Development
Division of Nicca Chemical Co., Ltd.
4-23-1 Bunkyo, Fukui City 910-8670
Japan

Process of Negotiations with Inventor Masahiro Makino Regarding Request for His
Signature

On May 16, 2006, Naoki Ogura of the Intellectual Property Administration Section of Research and Development Division of Nicca Chemical Co., Ltd. sent to Mr. Masahiro Makino an e-mail to arrange an appointment for a meeting with him with a view to requesting the inventor's signature in connection with the transfer procedures in the U.S.A. and Canada regarding the patent application on "A RUST-PREVENTIVE WATER-OIL SEPARATING CLEANER COMPOSITION AND A CLEANING METHOD USING THE SAME" and "A METHOD FOR GLOSSING SOLID SURFACE AND FILM-FORMING COATING LIQUID," but did not receive a reply to this e-mail until May 25, 2006.

Since Mr. Masahiro Makino's present address is unknown, on May 25, 2006, Naoki Ogura sent to Mr. Masahiro Makino an e-mail to ask him to put his signature on the documents, attaching thereto "English Patent Description," "Preliminary Amendment of Claim," "Declaration and Power of Attorney" and "Deed of Assignment" for the patent application in the U.S.A., and "Deed of Assignment" for the patent application in Canada as documents relating to "A RUST-PREVENTIVE WATER-OIL SEPARATING CLEANER COMPOSITION AND A CLEANING METHOD USING THE SAME" as well as "English Patent Description," "Preliminary Amendment of Claim," "Declaration and Power of Attorney" and "Deed of Assignment" for the patent application in the U.S.A., and "Deed of Assignment" for the patent application in Canada as documents relating to "A METHOD FOR GLOSSING SOLID SURFACE AND FILM-FORMING COATING LIQUID," and indicating the condition that incentives for the

assignment of inventions shall be provided in accordance with the terms and conditions stated in the "Control Procedures for Inventions and Ideas" and "Bylaws for Control of Inventions and Ideas" of Nicca Chemical Co., Ltd.

However, Naoki Ogura received an e-mail dated May 25, 2006 from Mr. Masahiro Makino informing that he would refuse to put his signature on these documents.

(A)

発明者：牧野公博氏へのサイン依頼交渉の経過について

日華化学（株）研究開発本部知的財産管理室の小倉直樹が、2006年5月16日に、特許出願「防錆性油水分離型洗浄剤組成物及び洗浄方法」並びに「固体表面の光沢付与方法及び被膜形成塗工液」の米国及びカナダへの移行手続に伴う発明者サインをお願いしたいので、面談したいとの要請文を牧野公博氏宛にメールで送ったが、このメールに対する返答は5月25日まで待っても来なかつた。

牧野公博氏の現在の住所が解らないので、5月25日に、「防錆性油水分離型洗浄剤組成物及び洗浄方法」に関する書類として、「英文明細書」、「請求項の予備補正書」、米国出願用の「宣言書と委任状」及び「譲渡証」、カナダ出願用の「譲渡証」、並びに、「固体表面の光沢付与方法及び被膜形成塗工液」に関する書類として、「英文明細書」、「請求項の予備補正書」、米国出願用の「宣言書と委任状」及び「譲渡証」、カナダ出願用の「譲渡証」をメールに添付し、発明の譲渡に対する報奨等は、日華化学の「発明・考案等管理規程」「発明・考案等管理細則」に規定されている条件に従って行うこと提示して、これらのサイン書類にサインを求めた。

しかしながら、5月25日付けの牧野公博氏からのメールで、サインを拒否する旨の連絡を受けた。

Sender: Naoki Ogura

Sent Date and Time: May 16, 2006, Tuesday, 15:52

Address: Mr. Masahiro Makino.

Subject: Request for Your Signature on Patent Application Documents

Dear Mr. Masahiro Makino,

It's been a long time. This is Ogura of Nicca Chemical.

I am writing this e-mail to you to ask for your signature on the relevant documents in connection with our application procedures in the U.S.A. and Canada regarding the two joint patent applications with Honda Motor Co., Ltd.: "A RUST-PREVENTIVE WATER-OIL SEPARATING CLEANER COMPOSITION AND A CLEANING METHOD USING THE SAME" and "A METHOD FOR GLOSSING SOLID SURFACE AND FILM-FORMING COATING LIQUID."

I would like to come to see you to give you our explanation and make a request, since there are some documents which require your signature on the relevant procedures.

I am sorry to bother you, but could you please let me know the date and place which would be convenient for you, if possible, from the next week onward?

I am looking forward to your favorable reply.

Naoki Ogura
Intellectual Property Administration Section
Research and Development Division
Nicca Chemical Co., Ltd.
4-23-1, Bunkyo, Fukui City 910-8670
TEL: (0776)22-1736 FAX: (0776)25-8597
E-mail: n-ogura@nicca.co.jp

(B)

小倉 直樹

差出人: 小倉 直樹
送信日時: 2006年5月16日火曜日 15:52
宛先: 「牧野公博 様」
件名: 特許出願書類へのサインのお願い

牧野公博 様

ご無沙汰をしております、日華化学の小倉です。

さて、今回メールをさせて頂きましたのは、本田技研工業（株）との共同特許出願2件「防鏽性油水分離型洗浄剤組成物及び洗浄方法」並びに「固体表面の光沢付与方法及び被膜形成塗工液」を、米国及びカナダへ出願手続いたしたく、その際に発明者の牧野さんにサインをお願いしたいので、ご連絡をさせて頂きました。

手続におけるサイン書類がいくつか有りますので、説明方々お願いに伺わせて頂きたいと思っております。

いろいろとご面倒をお掛けいたしますが、できれば来週以降で、牧野さんのご都合の良い日、場所をご連絡頂けないでしょうか。

宜しくお願ひいたします。

日華化学(株) 研究開発本部

知的財産管理室

小倉 直樹

〒910-8670 福井市文京4丁目23番1号

Tel : (0776)22-1736 Fax : (0776)25-8597

e-mail : n-ogura@nicca.co.jp

Sender: Masahiro Makino [makino-ma@nifty.com]

Sent Date and Time: May 25, 2006, Thursday, 19:29

Address: Naoki Ogura

Subject: Re: Request for Your Signature on Patent Application Documents

Dear Mr. Ogura,

It's been a long time.

My answer to the patent issue is the same as before.

I cannot change my mind once I make a resolution.

Last time I refused. So, if this time I agree, it is a contradiction.

>

----- Original Message -----

From "Naoki Ogura" <n-ogura@nicca.co.jp>

To: "Mr. Masahiro Makino" <makino-ma@nifty.com>

Sent: Thursday, May 25, 2006 12:58 PM

Subject: Request for Your Signature on Patent Application Documents

Dear Mr. Masahiro Makino,

This is Naoki Ogura of Nicca Chemical.

On May 16, 2006, I sent you my e-mail requesting that you meet me and let me explain about Inventor Mr. Makino's signature in connection with the application procedures in the U.S.A. and Canada regarding the two joint patent applications

with Honda Motor Co., Ltd: "A RUST-PREVENTIVE WATER-OIL SEPARATING CLEANER COMPOSITION AND A CLEANING METHOD USING THE SAME" and "A METHOD FOR GLOSSING SOLID SURFACE AND FILM-FORMING COATING LIQUID," but have not received your reply up to this moment.

Since your present address is unknown to me, I have taken the liberty of attaching the relevant documents to this e-mail to ask for your signature on them.

I will explain about the relevant documents attached hereto and the places where your signature is required. I am sorry to bother you, but would like to request you to print out the respective documents, place your signature at each place which requires your signature and send them to Naoki Ogura, Intellectual Property Administration Section, Research and Development Division, Nicca Chemical Co., Ltd.

Your kind attention to this matter will be highly appreciated.

By the way, incentives for the assignment of inventions shall be provided in accordance with the terms and conditions stated in the "Control Procedures for Inventions and Ideas" and "Bylaws for Control of Inventions and Ideas" of Nicca Chemical Co., Ltd, which is the same as the previous case with "Hydrophilic Treatment Composition and Hydrophilic Protective Film-Forming Method."

If you have any questions, please feel free to contact me at any time.

1. Documents relating to "A RUST-PREVENTIVE WATER-OIL SEPARATING

CLEANER COMPOSITION AND A CLEANING METHOD USING THE
SAME"

<<FP04-0348-00US-NCEnglishApplication.pdf>>

<<FP04-0348-00US-NC(preliminary amendment).pdf>>

FP04-0348-00US-NCEnglish Application.pdf

This is an English Patent Description. Please check the contents.

FP04-0348-00US-NC(preliminary amendment).pdf

This is a Preliminary Amendment of Claim. Please check the contents.

<<FP04-0348-00US-NC(Combined Declaration and Power of Attorney).pdf>>

FP04-0348-00US-US(Combined Declaration and Power of Attorney).pdf

This is a Declaration and Power of Attorney for the patent application in the U.S.A.

Please check the contents and place your signature and date on the line below the
print name on page 3.

<<FP04-0348-00US-NC(Assignment).pdf>>

FP04-0348-00US-NC(Assignment).pdf

This is a Deed of Assignment for the patent application in the U.S.A.

Please check the contents and place your signature and date on the place above the
print name on line 3):.

<<FP-0348-00CA-NC(Assignment).pdf>>

FP-0348-00CA-NC(Assignment).pdf

This is a Deed of Assignment for the patent application in Canada.

Please check the contents and write in the place and date of your signature and place

your signature on the place above the print name on line 3):.

2. Documents relating to "A METHOD FOR GLOSSING SOLID SURFACE AND FILM-FORMING COATING LIQUID"

<<FP04-0349-00US-NCEnglish Application.pdf>>

<<FP04-0349-00US-UC(preliminary amendment).pdf>>

FP04-0349-00US-NCEnglish Application.pdf

This is an English Patent Description. Please check the contents.

FP04-0349-00US-NC(preliminary amendment).pdf

This is a Preliminary Amendment of Claim. Please check the contents.

<<FP04-0349-00US-NC(Combined Declaration and Power of Attorney).pdf>>

FP04-0349-00US-NC(Combined Declaration and Power of Attorney).pdf

This is a Declaration and Power of Attorney for the patent application in the U.S.A.

Please check the contents and place your signature and date on the line below the print name on page 3.

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FP04-0349-00US-NC(Assignment).pdf

This is a Deed of Assignment for the patent application in the U.S.A.

Please check the contents and place your signature and date on the place above the print name on line 3):.

<<FP-0349-00CA-NC(Assignment).pdf>>

FP-0349-00CA-NC(Assignment).pdf

This is a Deed of Assignment for the patent application in Canada.

Please check the contents and write in the place and date of your signature and place
your signature on the place above the print name on line 3):.

Naoki Ogura
Intellectual Property Administration Section
Research and Development Division
Nicca Chemical Co., Ltd.
4-23-1, Bunkyo, Fukui City 910-8670
TEL: (0776)22-1736 FAX: (0776)25-8597
E-mail: n-ogura@nicca.co.jp



小倉 直樹

差出人: Masahiro Makino [makino-ma@nifty.com]
送信日時: 2006年5月25日木曜日 19:29
宛先: 小倉 直樹
件名: Re: 特許出願書類へのサインのお願い

小倉 様
ご無沙汰しております。
特許の件は、前回と同じです。
一度決心したからには、曲げることはできません。
前回、拒否して今回は了承することには矛盾が生じます。

----- Original Message -----

From: "小倉 直樹" <n-ogura@nicca.co.jp>
To: "牧野公博 様" <makino-ma@nifty.com>
Sent: Thursday, May 25, 2006 12:58 PM
Subject: 特許出願書類へのサインのお願い

> 牧野公博 様
>
> 日華化学の小倉です。
> 本田技研工業(株)との共同特許出願2件「防錆性油水分離型洗浄剤組成物及び洗
>
> 清方法」
> 並びに「固体表面の光沢付与方法及び被膜形成塗工液」の、米国及びカナダへの出願
>
> 手続に
> 伴う発明者牧野さんのサインの件で、お会いしてお話しをさせて頂きたいとのメール
>
> を5月
> 16日に発送いたしましたが、本日現在ご連絡を頂いておりません。
> 従いまして牧野さんの現在のご住所が不明なため、大変失礼かとは存じますが、
> メールで
> 関係書類を送付してサインをお願いさせて頂きます。
> 以下、添付いたしました関係書類の説明と、サインをお願いする箇所について説明
>
> いたしま
> すので、大変ご面倒をお掛けいたしますが、それぞれのサイン書類を印刷して頂き、
>
> サインの
> 必要箇所にサインをして、日華化学(株)知的財産管理室小倉直樹宛にお送り下さい
>
> ます様、
> 宜しくお願ひいたします。
> なお、発明の譲渡に対する報奨等は、先の「親水化処理剤組成物及び親水性保護膜
>
> 形成方法」
> の時と同様、日華化学の「発明・考案管理規程」「発明・考案管理細則」に規定され
>
> ている条件

> の範囲とさせて頂きまつ。
> また、不明な点などございましたら、何なりとお問い合わせ下さい様、宜しく
>
> お願い申
> し上げます。
>
> 1. 「防錆性油水分離型洗浄剤組成物及び洗浄方法」に関する書類
>
> <<FP04-0348-00US-NC英文出願.pdf>> <<FP04-0348-00US-NC
> (preliminary amendment).pdf>>
> FP04-0348-00US-NC英文出願.pdf
英文明細書です。内容をご確認下さい。
> FP04-0348-00US-NC(preliminary amendment).pdf
請求項の予備補正書です。内容をご確認下さい。
>
> <<FP04-0348-00US-NC(Combined Declaration and Power
> of
> Attorney).pdf>>
> FP04-0348-00US-NC(Combined Declaration and Power of Attorney).pdf
米国出願用の宣言書と委任状です。
> 内容をご確認の上、第3頁の名前のタイプの下の行にサイン
> と、日付をお願いいたします。
>
> <<FP04-0348-00US-NC(Assignment).pdf>>
> FP04-0348-00US-NC(Assignment).pdf
米国出願用の譲渡証です。
> 内容をご確認の上、3) :の行、名前のタイプの上の所にサイ
>
> ンと、日付をお願いいたします。
>
> <<FP04-0348-00CA-NC(Assignment).pdf>>
> FP04-0348-00CA-NC(Assignment).pdf
カナダ出願用の譲渡証です。
> 内容をご確認の上、3) :の行にサインをした場所、日付と、
>
> 名前のタイプの上の所に
サインをお願いいたします。
>
>
> 2. 「固体表面の光沢付与方法及び被膜形成塗工液」に関する書類
>
> <<FP04-0349-00US-NC英文出願.pdf>>
> <<FP04-0349-00US-NC(preliminary amendment).pdf>>
> FP04-0349-00US-NC英文出願.pdf
英文明細書です。内容をご確認下さい。
> FP04-0349-00US-NC(preliminary amendment).pdf
請求項の予備補正書です。内容をご確認下さい。
>
> <<FP04-0349-00US-NC(Combined Declaration and Power
> of
> Attorney).pdf>>
> FP04-0349-00US-NC(Combined Declaration and Power of

> Attorney).pdf
> 米国出願用の宣言書と委任状です。
> 内容をご確認の上、第3頁の名前のタイプの下の行にサイン
>
> と、日付をお願いいたします。
>
>
> <<FP04-0349-00US-NC(Assignment).pdf>>
> FP04-0349-00US-NC(Assignment).pdf
> 米国出願用の譲渡証です。
> 内容をご確認の上、3)の行、名前のタイプの上の所にサ
>
> インと、日付をお願いいたします。
>
>
> <<FP04-0349-00CA-NC(Assignment).pdf>>
> FP04-0349-00CA-NC(Assignment).pdf
> カナダ出願用の譲渡証です。
> 内容をご確認の上、3)の行にサインをした場所、日付
> と、名前のタイプの上の所に
> サインをお願いいたします。
>
>
> *****
> 日華化学(株) 研究開発本部
> 知的財産管理室
> 小倉 直樹
> 〒910-8670 福井市文京4丁目23番1号
> Tel : (0776)22-1736 Fax : (0776)25-8597
> e-mail : n-ogura@nicca.co.jp
> *****